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EXAMINER JAKOVAC, RYAN J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/801,043

**Applicant(s)**

LEAUTE ET AL.

**Examiner**

RYAN J. JAKOVAC

**Art Unit**

2445

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-11, 13, 14, 16-23, 26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 13, 14, 16-23, 26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Priority**

1. Applicant claims priority to Application No. 60/455483, filed 03/18/2003.

### ***Applicant Admitted Prior Art***

2. Applicant has admitted the following technologies to be "not new" (i.e. Applicant Admitted Prior Art, hereafter AAPA): P2P networks, Ad-Hoc DSL networks, Voice of WLAN or VoDSL, OpenNap protocols such as Napster P2P, XNAP Client, Napigator P2P servers, XML service and end-device capabilities based description, content auto-discovery for end user-identities and supported services, time based behavior of end-user identities and services, Application independence (gaming, Voice-chat, chat, instant messaging). See pg. 2-3 of 60/455483. Further AAPA on pg. 4 includes VoIP P2P, voice connections between P2P devices. AAPA on pg. 5 includes the aforementioned XNAP client and XNAP user query for XML files. AAPA also includes the methods further described on pg. 5 regarding personal XML service descriptions and searching/browsing user XML files. AAPA on pg. 6 includes transmitting bitstreams between P2P clients.

### ***Supporting Documents***

3. The supporting document entitled "XNAP Version History" has been included to illustrate several features (for example filtered searches) which were known to be present in the XNAP software prior to the Applicant's invention. Applicant's Admitted Prior Art includes the XNAP software.

### **Specification**

4. The amendment filed 02/22/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "The collaboration session may be independent of the P2P network." Applicant is required to cancel the new matter in the reply to this Office Action.

### **Response to Arguments**

5. Applicant's arguments with respect to claims 1-7, 9-11, 13-14, 16-23, 26, 28-29 have been considered but are not persuasive.

6. Applicant argues that AAPA and Mukherjee do not disclose or suggest *each identity file includes a tag representing information for a VOIP process of the end-user* as essentially recited in claim 1. The Examiner has stated that "if not inherent" these elements are obvious in view of AAPA and Mukherjee. Both AAPA and Mukherjee disclose locating end users. AAPA on pg. 6, discloses that it is well known to engage in a call (i.e. VoIP) once an end-user is located. Engaging in a VoIP call once an end user is located on a P2P network suggests including a tag representing information for a VoIP process of the located end user. For example, it would have been obvious to provide information indicating that the user is VoIP capable or is registered to use VoIP services as part of the identity file. Mukherjee further indicates that a user subscribing to a P2P service provides personal information for authentication, authorization and accounting purposes comprising a service ID number or other information used to authenticate the user of

the services (Mukherjee, [0039-0040]). Mukherjee indicates that a variety of P2P services may be provided, including VoIP, therefore it would be advantageous to include information with each identity file such as *a tag representing information for a VoIP process of the end-user to enable the VoIP session between the seeker device and the end-user* in order to indicate authorized or capable VoIP users or in order to indicate connection information relating to the VoIP process. This is further supported by AAP which discloses content auto-discovery for end-user identities and supported services. Claim 28 is rejected under similar rationale.

7. Applicant argues in summary that AAPA and Mukherjee do not disclose identity files having an XML format that include a tag representing a name of a potential collaborator on the P2P network and a tag representing a domain name of a collaborator as essentially recited as claim 10. First, it is noted that claims 10, 17, 28, and 30 recited essentially similar limitations as claim 1 and are rejected for similar rationale. Regarding a tag representing a name of a potential collaborator on a P2P network, fig. 4 of AAPA clearly shows user names displayed within user query. It is also well known and commonly understood that discovering user names (i.e. through identity files and their associated tags) is well known in the art. AAPA describes content auto-discovery for end-user identities and supported services. The Kaaza and Gnutella technology referenced by the Applicant as prior art systems typically use user name tags. This is also true of Napster, another known prior art P2P system. Providing a domain name for a user is an obvious variation over the cited prior art which shows user names and thus does not comprise a patentably distinguishable feature over the prior art.

8. Regarding the limitations of claim 17, the claim recites search entry fields “for entering names of collaborators”. However this is interpreted as intended use limitation and it has been

held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987). AAPA discloses performing a search and determining files corresponding to the name (i.e. a search entry) from the search entry fields. Further, searching for collaborators via a P2P GUI comprising search fields is well known in the art and present in the prior art systems (Kazaa, Gnutella, etc) recited by AAPA.

#### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-7, 9-11, 13-14, 17, 28 rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of US 20040006708 to Mukherjee et al (hereinafter Mukherjee).

Regarding claim 1, 10, 17, 28, 30, the combination of AAPA and Mukherjee teaches a system for discovering potential devices on a peer-to-peer (P2P) network to establish a voice over internet protocol (VOIP) session between P2P devices, comprising:

a seeker device (AAPA, pg. 2-3, 5, XNAP client, Napigator.); and

a plurality of end-user devices operatively connected to the P2P network (AAPA, pg. 5, fig. 4, plurality of P2P clients.);

wherein each of the plurality of end-user devices is associated with at least one identity files, each identity file comprising at least one searchable element (AAPA, pg. 5, searchable XML files.);

wherein at least one of the plurality of end-user devices post their at least one identity files on the P2P network (AAPA, pg. 2-5, P2P network, XML service and device description capabilities, content auto discovery for end-user identities, XNAP clients, searchable XML files posted to P2P networks.);

wherein the seeker devices searches the identity files posted on the P2P network to determine at least one device of the end-user devices for a VOIP session (AAPA, pg. 2-5.); and

wherein each identity file is an Extensible Markup Language (XML) file that is posted in a public shared directory on an end-user device and accessible using a P2P protocol (AAPA, pg. 5, fig. 4, plurality of searchable XML files posted to P2P networks.)

AAPA does not expressly disclose wherein the seeker device initiates the VOIP session with the determined end-user devices. However, Mukherjee discloses wherein the seeker device initiates the VOIP session with the determined end-user devices (Mukherjee, abstract, [0075], user devices communicate over a P2P network including VoIP communications.)

It would have been obvious to one of ordinary skill in the art at the time of the communication to combine the teachings of AAPA and Mukherjee in order to provide secure communications between user devices of a P2P network (Mukherjee, abstract.).

AAPA and Mukherjee do not disclose wherein each identity file includes a tag including information for a VoIP process of the end-user to enable the VoIP session between the seeker device and the end-user. However, both AAPA and Mukherjee disclose locating end users. AAPA on pg. 6, discloses that it is well known to engage in a call (i.e. VoIP) once an end-user is located. Engaging in a VoIP call once a end user is located on a P2P network suggests including a tag representing information for a VoIP process of the located end user. For example, it would have been obvious to provide information indicating that the user is VoIP capable or is registered to use VoIP services as part of the identity file. Mukherjee further indicates that a user subscribing to a P2P service provides personal information for authentication, authorization and accounting purposes comprising a service ID number or other information used to authenticate the user of the services (Mukherjee, [0039-0040]). Mukherjee indicates that a variety of P2P services may be provided, including VoIP, therefore it would be advantageous to include information with each identity file such as *a tag representing information for a VoIP process of the end-user to enable the VoIP session between the seeker device and the end-user* in order to indicate authorized or capable VoIP users or in order to indicate connection information relating to the VoIP process

Regarding claim 17, this claim is rejected under similar rationale as claim 1. AAPA does not expressly disclose downloading the P2P clients (comprising search forms), however, downloading client software it is commonly understood and well known in the art at the time of the invention and thus it would have been obvious to one of ordinary skill in the art to download



the client (i.e. comprising search forms, search functionality, etc. See also AAPA, pg. 2-5, p2p client includes search forms.)).

Regarding claim 2, the combination of AAPA and Mukherjee teaches the system of claim 1, wherein the seeker device is a seeker end-user device and the plurality of potential devices are a plurality of potential end-user devices (AAPA, pg. 2-5).

Regarding claim 3, the combination of AAPA and Mukherjee teaches the system of claim 2, wherein the seeker end-user device and each of the plurality of potential end-user devices comprises at least one of a personal digital assistant, a laptop, and a cellular phone (Mukherjee, fig. 5).

Regarding claim 4, the combination of AAPA and Mukherjee teaches the system of claim 1, wherein the at least one identity files of the plurality of the potential devices is downloaded from the Web service provider in response to the seeker device sending a Web service request to the Web service provider (AAPA, pg. 2-5).

Regarding claim 6, the combination of AAPA and Mukherjee teaches the system of claim 1, wherein the seeker device is a machine connected to an IP network (AAPA, 2-5. See supporting document “XNAP Version History”).

Regarding claim 7, the combination of AAPA and Mukherjee teaches the system of claim 1, wherein the P2P network comprises at least one of Kazaa, OpenNAP, Gnutella, FastTrack, LimeWire, eMule/Kademlia, and Napster (AAPA, pg. 2-5.).

Regarding claim 9, the combination of AAPA and Mukherjee teaches the system of claim 1, AAPA and Mukherjee do not disclose wherein the session is independent of the P2P network, however one of ordinary skill in the art would consider this an obvious variation of the system presented by AAPA and Mukherjee since it would be obvious to provide the option having an independent session to provide a separate communication session.

Regarding claim 11, the combination of AAPA and Mukherjee teaches the method of claim 10, further comprising performing identity provisioning (AAPA, 2-5. content auto-discovery for end user-identities and supported services. See also pg. 5, fig. 4.).

Regarding claim 13, the combination of AAPA and Mukherjee teaches the method of claim 10, further comprising obtaining service and identity availability for a result of the search results (AAPA, 2-5. content auto-discovery for end user-identities and supported services. See also pg. 5, fig. 4.).

Regarding claim 14, the combination of AAPA and Mukherjee teaches the method of claim 10, further comprising narrowing the search by searching only the identity files whose filenames include data for at least one of the search fields (AAPA, pg. 2-5, XNAP is known to

have search filters and ability to filter search results. See supporting document "XNAP Version History"). Further, searching within results amounts to applying a known technique to a known device/method to yield predictable results (see MPEP 2141) and would have been obvious to one of ordinary skill in the art at the time of the invention to include with the teachings of AAPA and Mukherjee.

11. Claims 5, 16, 18, 19-23, 26, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of AAPA and Mukherjee in view of "A Semantic Web based Peer-to-Peer Service Registry Network" by Uwe Thaden, Wolf Siverski, and Wolfgang Nejd1 (hereinafter Thaden).

Regarding claim 16, the combination of AAPA and Mukherjee teaches the method of claim 10, wherein discovering one or more entry point nodes to the P2P network comprises:

AAPA and Mukherjee do not expressly disclose, However, Thaden discloses:

querying a Web service running on a Web service cluster (Thaden, pg. 1-3, peer-to-peer registry network.);

receiving an identity form from a Web service provider in response to a Web service request (Thaden, pg. 1-5, image download service and search.),

the identity form comprises a plurality of information fields (Thaden, pg. 1-5, image download service has required input fields for searching.);

populating one or more of the plurality of information fields; and posting the identity form on the P2P network (Thaden, pg. 2-5, peer-to-peer query.).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combining the teachings of AAPA, Mukherjee, and Thaden in order to build a distributed discovery service and semantic query capabilities in a peer-to-peer infrastructure (Thaden, abstract, pg. 5.).

Regarding claim 5, the combination of AAPA and Mukherjee teaches the system of claim 1, wherein the seeker end-user device logs on a Web service provider to gain access to the P2P network using Web services and simple-object access protocols (SOAP) over hypertext transfer protocol (HTTP) and internet protocol (IP) networks (Thaden, pg. 1-2, web service called using WSDL and SOAP. Pg. 5, service clients access discovered services via SOAP.).

Regarding claim 18, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, wherein registering with a P2P network comprises registering automatically with the P2P network when the seeker device connects to an IP network (AAPA, 2-5. See supporting document "XNAP Version History").

Regarding claim 19, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, wherein initiating a Web service to a Web service provider comprises initiating a Web service to a Web service provider using HTTP/XML/SOAP protocols (AAPA, pg. 2-5.). Further, initiating a Web service to a Web service provider comprises initiating a Web service to a Web service provider using HTTP/XML/SOAP protocols amounts to applying a known technique to a known device/method to yield predictable results (see MPEP 2141) and

would have been obvious to one of ordinary skill in the art at the time of the invention to include with the teachings of AAPA and Mukherjee. Further, using HTTP/XML/SOAP protocols amounts to incorporating nonfunctional descriptive material. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Regarding claim 20, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, further comprising discovering the Web service provider using a UDDI Web service registry and business entities (Thaden, pg. 1-3, web services are provided to the client implemented in a registry search using UDDI and WSDL. Pg. 2, image download service provides searching capabilities. Pg. 1-2, web service called using WSDL and SOAP. Pg. 5, service clients access discovered services via SOAP.).

Regarding claim 21, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, wherein requesting an available P2P server on the P2P network from the Web service provider using the Web service comprises sending a Web service request using a Web service to the Web service provider, the Web service request requesting a list of available P2P servers (Thaden, pg. 1-4, UDDI service registries, web service registration, peer-to-peer registry network.).

Regarding claim 22, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 21, wherein sending a Web service request using a Web service to the Web service provider comprises sending a Web service request defined in a WSDL service descriptor file using a Web service to the Web service provider (Thaden, pg. 2, web service called using WSDL and SOAP. Pg. 5, service clients access discovered services via SOAP.).

Regarding claim 23, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, further comprising performing identity self-provisioning on the P2P network by: receiving an identity form from the Web service provider in response to a Web service request (AAPA, pg. 2-5. See XNAP client.); populating one or more of the plurality of information fields; and posting the identity form on the P2P network (AAPA, pg. 2-5, searchable XML user documents are posted and accessed via P2P network.).

Regarding claim 26, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 17, AAPA, Mukherjee, and Thaden do not disclose wherein the session is independent of the P2P network, however one of ordinary skill in the art would consider this an obvious variation of the system presented by AAPA, Mukherjee, and Thaden since it would be obvious to provide the option having an independent session to provide a separate communication session.

Regarding claim 29, the combination of AAPA, Mukherjee, and Thaden teaches the method of claim 10, wherein each identity file is stored as one of an XML file on a P2P shared

directory on a potential collaborator or on a distributed Hash Table on the P2P network (AAPA, pg. 2-5, searchable XML user documents are posted and accessed via P2P network.).

### **Conclusion**

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RYAN JAKOVAC/

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445